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In re Application of	:
KROPSHOFER et al	:
Serial No.: 10/676,675	:Decision on Petition
Filed : October 1, 2003	:
Attorney Docket No.: 21412	:

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on August 4, 2006 requesting withdrawal of the restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND

On March 10, 2006, the examiner mailed a restriction requirement in which the original claims 1-40 were divided into 56 groups. Part of this restriction requirement required selection of a specific sequence for examination.

On April 4, 2006, Applicants elected Group I (Claims 1-6 and 22-30) and SEQ ID NO: 1 with traverse.

On July 20, 2006 the examiner considered the traversal, made the restriction requirement final and mailed to applicants a non-final Office action, in which Group I (Claims 1-6 and 22-30) and SEQ ID NO: 1 were searched and examined on the merits.

On August 4, 2006, applicants filed this petition to request that the Office withdraw the restriction requirement.

On 6 November 2006, applicants filed an extension of time.

As of 12 March 2007, the Office has received no response to the Office action mailed 20 July 2006, accordingly, a notice of abandonment was prepared.

DISCUSSION

The petition and file history have been carefully considered. The petition sets forth four issues, requesting rejoinder of peptides, rejoinder of Group I and II, consideration of linking claims and consideration of independent and distinct inventions. These will be addressed in turn.

A. Rejoinder of Peptides

The petition filed August 4, 2006 requested the rejoinder of SEQ ID NOs: 1-4 as one group, SEQ ID NOs: 5-6 as one group; SEQ ID NOs: 7-8 as one group; SEQ ID NO: 9 as one group; SEQ ID NOs: 10-11 as one group; SEQ ID NOs: 12-13 as one group; and SEQ ID NO: 21 as one group. The petition identified the third group as containing SEQ ID Nos 7-9, however, the fourth group contains SEQ ID NO: 9. Thus, the argument has been interpreted to be requesting SEQ ID NO: 7-8 to be placed in one group.

The arguments contend that there is no serious burden to combine certain SEQ ID NOs into one group. As clearly pointed out in the petition on page 7 and the specification on page 44, SEQ ID NOs 1-4 are overlapping in scope. SEQ ID NO: 1 is position 202-217 of Vimentin; SEQ ID NO: 2 is position 203-217; SEQ ID NO: 3 is position 203-216; and SEQ ID NO: 4 is position 202-215. The other proposed groups by applicant are similarly overlapping and within the scope of each other. A search of the overlapping sequences SEQ ID Nos 1-4 would not create an undue burden in this particular application.

B. Rejoinder of Group I and II

The petition then argues that the antibodies of Group II are inseparable from the peptides of Group I because the antibody claims of Claims 7-9 are dependent on the antigenic peptide of Claim 1. This is not correct. While Claims 7-9 refer back to Claim 1, the antibodies of Claims 7-9 do not further limit the claimed peptides. As provided by 37 CFR 1.75, claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. As provided in MPEP 608.01(n)

> "The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim."

Because the antibodies of Claims 7-9 do not further limit the peptides of Claim 1, claims 7-9 are not considered to be dependant claims, Instead, claims 7-9 merely refers back to a previous claim. The antibody and the peptide do not fall within the same scope; one could infringe upon the antibody of claim 7 without infringing upon the peptide of claim 1

C. Consideration of Linking Claims

The petition correctly cites MPEP 809 for the direction provided for linking claims. However, the instant claim set does not contain a linking claim. A linking claim links two inventions. MPEP 809 specifically states "[l]inking claims and the inventions they link together are usually either all directed to products or all directed to processes (i.e., a product claim linking properly divisible product inventions, or a process claim linking properly divisible process inventions)." Here the two linked inventions would be identified as the peptide and the antibody. The claims do not present any claim(s) which encompasses both of these inventions.

As discussed at length in the restriction requirement, beginning on page 4, the inventions of peptides and antibodies are patentably distinct in that they each have unique structures and functions. Although the polypeptide and the antibody are both proteins, the primary, secondary and tertiary structures are completely different. Furthermore, the polypeptide functions as an enzyme. The antibody, on the other hand functions as a molecule which binds to epitopes. The peptides of Group I are defined in terms of SEQ ID NO: 1, while the antibody of Group II is defined in terms of its binding specificity to a small structure within SEQ ID NO: 1. As pointed out in the restriction requirement, art may be directed to the antibody prior to the discovery and disclosure of the peptide. Similarly, the antigenic peptides may be taught in the art, however an antibody may not be disclosed. Thus, art directed to one of these inventions may not necessarily be art against the other invention. Surely applicant would not accept a rejection directed to the antibody as evidence of the obviousness of the antigenic peptide claim. Nor would applicant likely accept a rejection direct to an antigenic peptide as evidence of the obviousness of an antibody claim.

As indicated in the original restriction requirement, page 9 of restriction mailed March, 10, 2006, applicants were given the opportunity to have the restriction requirement withdrawn by stating clearly on the record that the inventions were not patentably distinct. "Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention." To date, applicants have not availed themselves of this option.

The peptides of Group I and the antibodies of Group II represent patentably distinct inventions and are not linked by any linking claim. Thus, the restriction requirement between these inventions is affirmed.

D. Consideration of Independent and Distinct Inventions

Finally, the petition states that the Director does not have the authority or discretion to restrict inventions that are not both "independent" and "distinct" under 35 U.S.C 121. The petition cites 809.01 for the meaning of "independent". It is noted that the cited passage appears in MPEP 802.01 rather than 809.01. A review of the legislative intent behind the passage of the 1952 Act can be found in MPEP 802 which discusses the meaning of independent" and "distinct".

> 35 U.S.C. 121 quoted in the preceding section states that the Director may require restriction if two or more "independent and distinct" inventions are claimed in one

application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application. This raises the question of the inventions as between which the Director may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent, or unrelated. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes." The report on the hearings does not mention as a change that is introduced, the inventions between which the Director may properly require division. The term "independent" as already pointed out, means not dependent, or unrelated. A large number of inventions between which, prior to the 1952 Act, division had been proper, are dependent inventions, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Director never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Director has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above.

Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

The petition asserts that "the term 'independent' does not include dependent claims dependent on independent claims and that "no dependent claims should ever be restricted." This assertion does not appear to be supported by the plain language of MPEP 802.01. Rather, 35 USC 121 and the MPEP are directed to independent (unrelated) and dependent (related) inventions and does not speak to the format of individual claims, whether they are drafted in independent or dependent claim format. The specific language states, "the Director has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions."

DECISION

The petition is **GRANTED–IN-PART** for the reasons set forth above.

Claims 1-6 and 22-30 are under examination. SEQ ID NO: 2, 3, and 4 are rejoined with the SEQ ID NO: 1 already under examination.

SEQ ID NOs: 5-6 are rejoined as one group;
SEQ ID NOs: 7-8 are rejoined as one group;
SEQ ID NOs: 9 will remain one group;
SEQ ID NOs: 10-11 are rejoined as one group;
SEQ ID NOs: 12-13 are rejoined as one group; and
SEQ ID NOs: 21 will remain one group.

The request to withdraw the restriction requirement between Group I and II has been denied.

As of 12 March 2007, it appears that the Office has received no response to the Office action mailed 20 July 2006. Accordingly, the examiner has prepared a Notice of Abandonment. The filing of a petition does not waive applicants' obligation to respond to an Office action within the time period set within.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

John LeGuyader
Director, Technology Center 1600
jb/jg